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Patent and Trademark Office (P.T.O.)

EX PARTE PRIMA SORIANO

APPEAL NO. 77439119

August 24, 2009

Application for Trademark/Service Mark

“tomKIT” (Time of the Month)
(Stylized and/or with Design)

PRIMA SORIANO
Serial No. 77439119
Filed: April 3, 2008
primasoriano@pacbell.net



11-24-2009

STATEMENT OF THE CASE

On April 3, 2008, applicant, Prima Soriano filed an application for registration for the trademark/service mark identified as “tomKIT time of month,” International Class 044: Hygienic and beauty care, filed under Section 1(b), intent to use, in which Prima Soriano declared that it has a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the identified goods and/or services.¹ The literal element of the mark consists of *tomKIT time of month*. The color(s) blue, orange is/are claimed as a feature of the mark. The mark consists of tomKIT time of month with blue letters t, o, m, and orange letters K, I, T, and an orange flower inside the blue letter o, time of month under tomKIT in blue lower case letters.

On February 25, 2009, Trademark Examining Attorney, Janice L. McMorrow, notified Prima Soriano that their registration had been denied for the following reasons:

1. The specimen fails to show proper use of the applied for mark in the sale or advertising of the services.
2. The specimen is not acceptable because it does not show the applied for mark in use in commerce.
3. A statement of use must include a specimen showing the applied for mark in use in commerce for each class of services in the statement of use.²
4. The current specimen, a hangtag attached to a cosmetic kit, makes no reference to the hygienic and beauty care services for which registration is sought.

On August 24, 2009, Prima Soriano submitted a Request for Reconsideration of the refusal to register the mark “tomKIT,” and accordingly, the appeal was instituted, but suspended pending the consideration by Ms. McMorrow. On September 11, 2009, Ms. McMorrow notified Prima Soriano

¹ 15 U.S.C. Section 1051(b), as amended.

² Trademark Act Sections 1 and 45, 15 U.S.C. Sections 1051, 1127; 37 C.F.R. Sections 2.56, 2.88(b)(2); TMEP Sections 904, 904.07(a), 1109.09(b).

that the request for reconsideration had been denied. The appeal was therefore reinstituted and the proceedings were resumed, which allowed time for Prima Soriano to file a brief on its appeal. According to Ms. McMorrow, "Objection was taken against the mark on the grounds that the substitute specimen is unacceptable because it fails to show use of the proposed mark in connection with the services." Pending a proper response, registration is refused because the specimen does not show the applied for mark in use in commerce for the services specified in the statement of use.³

RESPONSE TO DENIED REGISTRATION OF MARK

This appeal is in reply to Ms. McMorrow's decision to reject the registration of the mark tomKIT. Prima Soriano will address each reason for denial of the mark as follows:

1. The specimen fails to show proper use of the applied for mark in the sale or advertising of the services.

As stated in Ms. McMorrow's denial of February 25th, she bases her rejection on the specimen which consisted of a hangtag attached to a kit, and stated that it was unacceptable as evidence of actual service mark use because it makes no reference to the "hygienic and beauty care" services for which the registration is sought. The picture of the cosmetic kit with the "hangtag" attached to the zipper was one example of how the mark would be used in identifying the time of the month product for women. The picture represents the "Kit" which includes several menstrual products for females to be used during their "time of the month." The hangtag was an example of how the mark would be used to identify the kit to girls and women who would be purchasing it for their use. Prima Soriano filed under Class 044, section 1(b), intent to use, the applicant declares that it has a bona fide intention to use tomKIT with the identified goods and/or services.⁴ Prima Soriano would like to point out that in Ms. McMorrow's letter of February 2, 2009 she states that the mark is unacceptable in the sale and advertising of "services" only. The hygienic and beauty care products

³ 15 U.S.C. Sections 1051, 1127; 37 C.F.R. Sections 2.56, 2.88; TMEP Sections 904, 904.07(a), 1109(b).

⁴ Goods and/or Services are described under 15 U.S.C. Section 1051(b), as amended.

that are being sold under the mark tomKIT are specifically “goods,” not services and the category specifically identifies goods and/or services. There is no product only section for hygienic and beauty care.

2. The specimen is not acceptable because it does not show the applied for mark in use in commerce.

When Prima Soriano received the notice of Allowance dated November 18, 2008, they were given six months to file a statement of use and asked to pay \$100. An Allegation of Use was filed along with the \$100 fee. The e-mail receipt dated January 5, 2009 from the U.S.P.T.O. identified the use of the mark tomKIT in International Class 44: Current Identification: Hygienic and Beauty Care, and as stated “The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class.” In the submission Prima Soriano included samples of how the mark was used for goods in commerce. These samples included were several pages from the tomKIT webpage, www.tomKIT.net: showing the environmentally friendly feminine hygiene products and how to purchase them.

In order to comply with Ms. McMorrow’s instructions, the following substitute specimens showing the mark in use in commerce for the services specified in the statement of use are attached as follows: (1) Brochure describing the products and including a time of month cycle chart (2) copy insert card that each purchaser receives with the purchase of the tomKIT, (3) information sheet describing product information (4) Reliable expert reviews including pictures of the kits and contents (5)web page printouts (6) hangtag

Again, however, the above relates to how the mark will be used in relation to the goods that are provided to the public, girls and women to be specific. The goods are included in a tomKIT and it could be said that the service it provides is the hygienic care available to girls and women in addition to teaching a new generation of consumers, the benefits of using environmentally friendly products.

A statement of use must include a specimen showing the applied for mark in use in commerce for each class of services in the statement of use.

Prima Soriano shows the mark] tomKIT in use in commerce to designate “goods” on their tomKIT web page, their product reviews, their insert cards, their information sheet, their cycle chart , their hang tag and their facebook page.

3. The current specimen, a hangtag attached to a cosmetic kit, makes no reference to the hygienic and beauty care services for which registration is sought.

Prima Soriano respectfully rejects the decision made by Ms. McMorrow in basing her decision on a photograph of a “hangtag attached to a cosmetic kit” as a reference to hygiene and beauty care services. Although the kit may look like a cosmetic case, it is not cosmetic, nor does it contain cosmetic products. It contains environmentally friendly feminine hygiene items such as pads, liners, wipes, hand sanitizers, spare underpants and disposal sacks. It was not intended to give the impression that the hangtag was referencing services.

Resubmitted is a substitute specimen of the tomKIT with examples of what is contained inside the kit. The hangtag references the name tomKIT as a visual identification to the public so that when they see the words tomKIT, they know that it relates to feminine products and hygiene.

Substitute Specimens

Included with EX PARTE PRIMA SORIANO

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tomKIT (Time of Month)

Prima Soriano

primasoriano@pacbell.net

1. tomKIT hangtag
2. tomKIT insert card
3. tomKIT brochure with cycle chart
4. pages from tomKIT website; www.tomkit.net
(included are home page, shopping cart, and reviews by experts...Kudos pages)
5. tomKIT information sheet on contents inside the kit

[Home](#) [Green Living](#) [Products](#) [Green Teens](#) [Kudos](#) [About Us](#)
[Customer Service](#) [Shopping Cart](#)

tóm

(tóm-KIT)

1. a "time of month" emergency girl pack
2. an eco-friendly opportunity to make a difference in the environment
3. a chic way to carry feminine hygiene products



Ginger



Pokka

+ Convenient =



Facebook

Home Green Living Products Green Teens Kudos About Us
 Customer Service Shopping Cart

GREEN KUDOS

t m

IDEAL BITE....a sassier shade of green



"tomKIT makes your time-of-month a little easier to deal with; great for emergencies, it includes must-have wipes, pads, and a spare pair of biodegradable underwear."

GORGEOUSLY GREEN -Sophie Uliano....New York Times best selling author



"Landfills are running out of space and thank goodness some very smart women have thought about this and come up with tomKIT (time of month)."

COOL MOM PICKS -Kristin Chase....Co-owner



"tomKIT makes an uncomfortable time of the month a little more comfortable and is also a great gift for the eco-tween in the house. Because saving the earth is great, but saving your daughter from the little silver box in the women's restroom is a close second."

ALTERNATIVE CONSUMER-Maureen O'Connor....Founder and Publisher

"The only thing more than being concerned about the

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SHOPPING CART

t m

Our "Emergency Girl Pack" includes:

Natural jute cosmetic case
3 winged pads
3 panty liners
3 feminine wipes
3 disposal sacks
1 pair cotton bikini underwear
Hand sanitizer
Ganache lip balm
Cycle chart
\$20.00 (Originally \$25.00)



Ginger

Style

Ginger

[Add to Cart](#)



Pokka

Refill Packet includes:

15 winged pads
15 panty liners
15 feminine wipes
10 disposal sacks
1 pair cotton bikini underwear
\$12.00 (Originally \$15.00)



[Add to Cart](#)

Ganache for Lips

Lip balm made with Scharffen Berger
chocolate
All natural
\$4.50



[Add to Cart](#)

Disposable bikini underpants
4 pair in small, medium or large
Biodegradable and 100% cotton
Wash or toss
\$5.50

Size

Small

[Add to Cart](#)





Information Sheet www.tomkit.net

GENERAL INFORMATION

Women use 10,000 – 15,000 feminine hygiene products in their lifetime. Solid waste is a major problem. Approximately 20 billion feminine hygiene products are used every year in North America with one trillion ending up in landfills by 2030. The products take over 200 years to decompose.

PRODUCT INFORMATION

Our jute case – Jute is an environmentally friendly, natural fiber. It is also biodegradable, compared to synthetics. The kits are custom designed to be compact, chic and to conveniently fit all of our products.

Our pads and liners – they are both made with new technology, a revolutionary film that replaces plastic film. It has all the properties of plastic for the purpose of containing fluids, yet it begins to breakdown as soon as it comes in contact with the water in the toilet bowl. The swirling action and agitation in the bowl begins to break it down so it is flushable. The rest of the material breaks apart while flowing through the pipes and biodegrades in 71 days; 66% faster than the international standard requires.

Our feminine wipes – they are also flushable. They gently and effectively cleanse sensitive skin. They contain natural moisturizers and extracts, aloe vera and vitamin E.

Our cotton underwear – the brief is 100% cotton, extremely comfortable, lightweight, soft and disposable....wash or toss. Products made of cotton are biodegradable because microbes, including fungi and bacteria found in soil, secrete enzymes that cause the chemical breakdown when combined with moisture and heat.

Our hand sanitizer – it's plant based, certified organic, a soothing essence, a convenient travel size and contains 100 sprays.

Our lip balm – this is a special treat...made with Sharffen Berger chocolate. The ingredients include shea butter, vitamin E, apricot kernel and rosemary extract. It's a delicious tasting ganache for lips and is made without petroleum products and is made with no animal testing.

Our cycle chart – it's a keeper, to log the days each month. All of our printing, including cycle chart, tags, etc. is done on recycled paper.

Our **EMERGENCY GIRL PACK** is useful for any woman (of "period" age) and for tweens and teens anxiously awaiting the day. It also makes a great gift for moms of preteen girls to have on hand. One never knows when that unexpected first period will arrive and it is ideal to have a present ready to celebrate the moment. It also inspires the next generation to start environmental habits.